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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/153,782	09/16/1998	VANCE C. BJORN	03022.P011	6034

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 900251026

EXAMINER

COUSO, YON JUNG

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/153,782

Applicant(s)

BJORN ET AL.

Examiner

Yon Couso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/4/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13, 15-17, 23, 24, 30, 31 is/are rejected.
- 7) ☒ Claim(s) 6-12, 14, 18-22 and 25-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

a. The applicants argue that the touchpad of Ferrari operates as a fingerprint recognition device only when the user first logs on. The applicants further argues that Ferrari does not teach or suggest configuring the touchpad to operate as both a fingerprint sensor and cursor control based on parameters. The examiner disagrees. The parameter in this case could be the time. Therefore when the user first logs on, the touchpad is configured to perform fingerprint recognition. Thereafter (time), the touchpad is configured to operate as pointer device. The "parameter" has such a broad meaning that initial activation of fingerprint recognition in the Ferrari still reads on the claimed language. The applicants are reminded that the examiner is entitle to give the broadest reasonable interpretation to the language of the claims. Therefore, the examiner is not limited to applicant's limited interpretation, which is not specifically set forth in the claims, In re Tanaka et al 193 USPQ, 139 (CCPA 1977).

b. The applicants argue that Ferrari does not discuss switching functionality between fingerprint recognition and pointer control. It is noted that switching functionality between fingerprint recognition and pointer control is not a limitation of the claims. Applicant is reminded of 37 CFR 1.111(b) which states that, a "general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section".

c. The applicants argue that Ferrari and Keagy combined do not teach or suggest the use of fingerprint parameters to configure the device to either capture a fingerprint for identification or to use the fingerprint for pointer movement control. The examiner disagrees. Even though Ferrari does not teach details on fingerprint platform comprising a sheet prism, Ferrari teaches the fingerprint platform (125 in figures 6 and 7). The use of a sheet prism as a fingerprint is well-known in the art. For example, in figure 2 (see also figured 3 and 4), Keagy discloses the sheet prism (fingerprint platen 10, see also column 4, lines 30-35) being used as the fingerprint platform (see column 6, lines 14-35). It would have been obvious to one of ordinary skilled in the art to use platen 10 as shown by Keagy for fingerprint platform of Ferrari because such a modification will make the system of Ferrari at a sufficiently low cost and also improve the contrast of the fingerprint image (Keagy at column 4, lines 48-52 and lines 24-30).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 13, 15-17, 23, 24, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrari et al (US Patent No. 6,392,636).

As per claim 1, Ferrari teaches a touchpad device configured to be a pointer control device and a fingerprint recognition device, the touchpad device, comprising: a

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detection array having a detection surface, wherein the detection surface is configured to receive a fingerprint image (column 6, lines 50-56); a processor device to receive image data from the detection array, the processing device further to configure the touchpad device to operate as the pointer control device to move a cursor or the fingerprint recognition device based upon parameters associated with the image data (column 8, lines 48-54 and column 4, lines 29-40).

As per claim 2, Ferrari teaches a fingerprint platform, wherein the fingerprint platform is configured to supply a fingerprint image to the detection surface of the detection array (column 6, line 57-column 7, line 30).

As per claim 5, Ferrari teaches the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (column 10, line 64-column 11, line 10).

As per claim 13, Ferrari teaches the processing device is configured to translate the position of the fingerprint image on the detection surface into a cursor position on an interface area of a display when the touchpad device operates as a pointer control device (column 9, lines 14-19).

As per claim 15, Ferrari teaches a multi-function device configurable to be a pointer control device and a fingerprint recognition device, the multi-function device comprising: means for supplying a fingerprint image to a detection surface of a detection array (column 6, lines 50-56); means for processing the fingerprint image supplied to the detection array, wherein the means for processing configures the multifunction device to operate as a pointer control device or a fingerprint recognition

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device based upon parameters associated with the fingerprint image (column 8, lines 48-54).

As per claim 16, Ferrari teaches the means for processing is configured to selectively operate the multi-function device as a pointer control device or a fingerprint recognition device based upon parameters associated with the fingerprint image (column 4, lines 29-40).

As per claim 17, Ferrari teaches the multifunction device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (column 10, line 64-column 11, line 10).

As per claim 23, Ferrari teaches a method of analyzing a fingerprint image to configure the operation of a multi-function device, the multi-function device configurable to be a pointer movement control device and a fingerprint recognition device, the method comprising: supplying a fingerprint image to a detection surface of a detection array (column 6, lines 50-56); analyzing select fingerprint parameters associated with the fingerprint image (column 8, lines 48-54); configuring the multi-function device to operate as the pointer movement control device or the fingerprint recognition device based upon the fingerprint parameters associated with the fingerprint image (column 8, lines 48-54 and column 4, lines 29-40).

As per claim 24, Ferrari teaches the multi-function device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (column 10, line 64-column 11, line 10).

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As per claim 30, Ferrari teaches translating the position of the fingerprint image supplied to the detection surface of the detection array into a cursor position on an interface area of a display when the multi-function device is configured to operate as a pointer control device (column 9, lines 14-19).

As per claim 31, Ferrari teaches performing fingerprint authentication on the fingerprint image supplied to the detection surface of the detection array when the multi-function device is configured to operate as a fingerprint recognition device (column 8, lines 48-54).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al in view of Keagy et al.

The arguments advanced in paragraph 2 above as to the applicability of the reference are incorporated herein.

As per claims 3 and 4, Ferrari does not teach details on fingerprint platform comprising a sheet prism. However, Ferrari teaches the fingerprint platform (125 in figures 6 and 7). The use of a sheet prism as a fingerprint is well-known in the art. For example, in figure 2 (see also figured 3 and 4), Keagy discloses the sheet prism (fingerprint platen 10, see also column 4, lines 30-35) being used as the fingerprint platform (see column 6, lines 14-35). It would have been obvious to one of ordinary skilled in the art to use platen 10 as shown by Keagy for fingerprint platform of Ferrari because such a modification will make the system of Ferrari at a sufficiently low cost and also improve the contrast of the fingerprint image (Keagy at column 4, lines 48-52 and lines 24-30).

4. Claims 6-12, 18-22, 25-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yon Couso whose telephone number is (703) 305-4779.

The examiner can normally be reached on 8:00 am –4:30 pm from Monday to Friday

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


YON J. COUSO
PRIMARY EXAMINER

Yjc

August 5, 2004